

REMARKS

Pursuant to 37 C.F.R. § 1.111, Applicants respectfully request reconsideration of the claim rejections set forth in the Office communication dated September 20, 2007.

Summary

Claim 11 is currently amended.

Claims 11 – 16 and 18 – 25 are currently pending.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Claims 11 – 25 were rejected pursuant to 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

In regards to previous claim 11, which recited non-currency grade paper, the Examiner stated: "Neither the instant claims or specification teaches how much starch content is in non-currency grade paper, which makes it difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed." Claim 11 has been amended and does not include "non-currency grade paper."

Claims 14 and 23 still recite non-currency grade paper. In response to the Examiner's statement, the specification clearly conveys to one skilled in the art the inventor had possession of the claimed invention. First, Applicant reemphasizes the "relational nature" of claim 14. Claim 14 does not claim the amount of starch content in the non-currency grade paper. Rather, claim 14 recites the starch content of the first material is lower than the starch content of the coupon formed by non-currency grade paper. Second, one skilled in the art would know "how much starch content is in non-currency grade paper." As evidence of this conclusion, Applicant submitted ten (10) references with the Response to Office Action Dated March 22, 2007 and Advisory Action Dated June 13, 2007.

As further support for Applicant's conclusion that claim 14 satisfies the enablement requirement, Applicant submits the previous Office action dated September

20, 2007. On page 3 of the Office action, the Examiner stated: "Ahlm, Jr. is silent of starch, it is a good ascertainment that the coupon and first material are free of starch, rendering it to have a lower starch content than non-currency grade paper" (Office action dated 20 September 2007; page 3; emphasis added). The Examiner did not know "how much of starch content is in the non-currency grade paper," but was able to logically conclude that other materials had a lower starch content than the non-currency grade paper. This is evidence that one skilled in the art would understand the amount of starch content in non-currency grade paper does not need to be defined to be definite.

Please also note that the statement is incorrect. Typical paper, such as used in coupons, includes starch. Silence indicates starch to a person of ordinary skill. Non-currency grade paper would indicate starch. Currency grade paper would indicate no or little starch.

Amended claim 11 recites a method for verifying the authenticity of a coupon comprising, *inter alia*, providing, on or within the coupon, a first material having a lower starch content than the coupon.

Amended claim 11 is fully supported by the specification as originally filed. For example, paragraph [0019] of the originally specification recites: "The coating has a different, such as higher, lesser or no, trace chemical residual content than the coupon or non-currency grade paper." The Examiner was concerned about "how much starch content is in non-currency grade paper" (Office action dated 20 Sept. 2007). To eliminate this concern, Applicant removed the term "non-currency grade paper" from claim 11. There should be no further confusion over how much starch content is in non-currency grade paper. Therefore, claim 11 is in condition for allowance.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 11 -24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 11 recites a method for verifying the authenticity of a coupon comprising, *inter alia*, providing, on or within the coupon, a first material having a lower starch content than the coupon.

Amended claim 11 is definite. One skilled in the art would understand the relational nature of claim 11. Therefore, claim 11 is in condition for allowance.

Claim 25

Claim 25 was added in the Response to Office Action Dated March 22, 2007 and Advisory Action Dated June 13, 2007 ("the Response"). A Request for Continued Examination (RCE) was filed with the Response. Because of the RCE, previously added claim 25 should have been given substantive consideration by the Examiner in the previous Office action dated September 20, 2007. However, claim 25 was not considered, or at least, claim 25 was not discussed in the Office action dated September 20, 2007. Therefore, should the claims be rejected again, Applicant respectfully requests that the subsequent Office action be a non-final action in order to give Applicant reasonable time to respond to substantive consideration of claim 25.

The following remarks for claim 25 were presented on page 15 of the Response to Office Action Dated March 22, 2007 and Advisory Action Dated June 13, 2007.

During the telephonic interview dated 9 August 2007, Examiner Cano requested that the Applicants define the amount of starch in the first material in order to overcome the claim rejections pursuant to 35 U.S.C. § 112. Claim 25 recites a first material being substantially free of starch.

During the telephonic interview dated 9 August 2007, Examiner Cano requested that the Applicants define the amount of starch in the coupon in order to overcome the claim rejections pursuant to 35 U.S.C. § 112. Claim 25 recites that the starch content of the coupon is higher than the starch content of the first material.

Applicant removed the term "non-currency grade paper" from the claim 25. Therefore, there is no confusion as to how much starch content is in the non-currency grade paper.

As requested by Examiner Cano, both the amount of starch in the first material and the coupon is clearly defined. Therefore, claim 25 overcomes the claim rejections pursuant to 35 U.S.C. § 112.

Claim 25 also recites the first material being such that the chemical generates a light mark when the coupon is authentic and a dark mark when the coupon is not authentic. Examiner Cano kindly suggested defining the first material. Examiner Cano suggested including a limitation that recited "the first material being such that..." In order to expedite prosecution, claim 25 includes such a limitation. Applicants have further defined the relationship and reaction between the first material and the chemical. Therefore, claim 25 is also definite for at least this reason.

Claim Rejections – 35 U.S.C. §§102(b) and 103(a)

Claims 11 – 14, 16, 18 – 23 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ahlm, Jr. et al (U.S. Patent No. 3,001,887). Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ahlm, Jr. et al. in view of Kurrle (U.S. Patent No. 6,214,766). Claims 11 – 16, 18 – 23 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kawashima (U.S. 5,415,434). Claim 24 was rejected under 35 U.S.C. § 103(a) as being unaptentable over Kawashima in view of Kurrle.

Claim 11 recites a first material having a lower starch content than the coupon.

Ahlm, Jr et al. fail to disclose a first material having a lower starch content than the coupon. The Examiner cites the paper document 10 as the coupon and the indistinguishable material 11 (invisible colloidal silica in Figure 1) as the first material. The Examiner stated that "Alhm, Jr. is silent of starch, it is a good assertion that the coupon and first material are free of starch, rendering it to have a lower starch content than non-currency grade paper" (Office action dated 20 September 2007; page 3). If

the indistinguishable material 11 and the paper document 10 are both "free of starch," it is impossible for the indistinguishable material 11 ("first material") to have a lower starch content than the paper document 10 ("coupon"). Therefore, claim 11 is allowable over the cited reference.

Kawashima fails to disclose a first material having a lower starch content than the coupon. The Examiner cites the printed matter 1 as the coupon and the coloring compound (ink) 3 as the first material. The Examiner stated that "Because Kawashima is silent of starch, it is a good assertion that the coupon and first material are free of starch, rendering it to have a lower starch content than non-currency grade paper." (Office action dated 20 September 2007; page 5). If the printed matter 1 and the ink 3 are both "free of starch," it is impossible for the ink 3 ("first material") to have a lower starch content than the printed matter 1 ("coupon"). Therefore, claim 11 is allowable over the cited reference.

Amended claim 11 recites a light mark results from an interaction between the first material and the chemical.

Ahlm, Jr et al. fail to disclose a light mark results from an interaction between the first material and the chemical. Ahlm, Jr. et al. disclose an interaction between an indistinguishable material (invisible colloidal silica) 11 and a colorless developing solution 13. The indistinguishable material 11 is printed (e.g., "VALID") on the paper document 10 (col. 3, lines 35 – 37; Figure 1). Figure 1 shows "a conventional roller carrying a film of colorless developing solution 13 of this invention, which when brought into contact with the latent printed words, develops the word in color" (col. 3, lines 37 – 42; Figure 1; emphasis added). As shown in Figure 1, Ahlm, Jr. et al. teach an interaction between an indistinguishable material 11 and a colorless developing solution 13 results in a dark (color) mark. Ahlm, Jr. et al. does not disclose an interaction between the indistinguishable material (invisible colloidal silica) 11 and a colorless developing solution 13 that results in a light mark. Therefore, claim 11 is allowable over the cited references.

Kawashima fails to disclose a light mark results from an interaction between the first material and the chemical. Kawashima teaches:

A printed matter 1 has, on a surface of paper 2, a color coupling area Y such as a hidden picture printed by an ink 3 containing a color coupler that is changed from a colorless to a colored state. And the color coupling area Y is developed from a colorless state, and expressed in a colored stated by application of a color coupling additive 5 comprising a specified electron acceptive developing compound.
(col. 2, lines 57 – 64; emphasis added).

Kawashima teaches an interaction ("by application") between ink 3 containing a color coupler and a color coupling additive 5. The result of the interaction is a dark (colored state) mark. Kawashima fails to disclose a light mark results from an interaction between the ink 3 and color coupling additive 5. Therefore, claim 11 is allowable over the cited reference.

Amended claim 11 recites the chemical is operable to interact with a non authentic paper, having a starch content and not having the first material, to produce a dark mark.

Ahlm, Jr et al. fail to disclose a chemical that is operable to interact with a non authentic paper, having a starch content and not having the first material, to produce a dark mark. As discussed above, Ahlms, Jr. et al. disclose indistinguishable material 11 that interacts with the chemical agent to produce a dark mark. The Examiner stated: "it is inherent that the coupon is authentic when a light mark results from applying chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon" (Office action dated 20 September 2007; page 4). Applicant disagrees. One skilled in the art would understand that if the indistinguishable material 11 was added to a non authentic paper (a second paper), which did not include the chemical

agent, the result would be a light mark. Consider the area in Figure 1 that is not covered by the chemical agent. The result in this area is a light mark. This contradicts the conclusion that a dark mark on a non authentic paper is inherent. Ahlms, Jr. et al. fail to disclose indistinguishable material 11 that interacts with a non authentic paper, not having the chemical agent, to produce a colored mark. Therefore, claim 11 is allowable over the cited reference.

Kawashima fails to disclose a chemical that is operable to interact with a non authentic paper, having a starch content and not having the first material, to produce a dark mark. As discussed above, the coloring compound 3 interacts with the coloring coupling additive 5 to produce a colored mark. The Examiner stated: "it is inherent that the coupon is authentic when a light mark results from applying chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon" (Office action dated 20 September 2007; page 5). Applicant disagrees. One skilled in the art would understand that if the coloring coupling additive was added to a second paper (non authentic paper), which does not contain the coloring compound, the result would be a light mark. This contradicts the conclusion that a dark mark on a non authentic paper is inherent. Kawashima fails to disclose a chemical additive that interacts with a non authentic paper, not having the coloring compound, to produce a colored mark. Therefore, claim 11 is allowable over the cited reference.

Dependent claims 12 – 16 and 18 – 19 depend from allowable claim 11, so are allowable for at least this reason.

Claim 20 recites, *inter alia*, a light color change indicates that the coupon is authentic and a dark color change indicates that the coupon is not authentic. Claim 20 recites features that are similar to the allowable features of claim 11. Therefore, claim 20 is allowable for at least this reason.


Dependent claims 21 – 24 depend from allowable claim 20, so are allowable for at least this reason.

CONCLUSION

For at least the reasons presented above, the Applicants respectfully submit that the pending claims are in condition for allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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